

REMARKS

Amendments to the Claims

Claims 3, 5-8, and 10-13 are currently pending.

Claims 5, 7, and 10-12 were allowed in the Office Action of July 21, 2008.

Claims 5, 6, and 7 have been amended to clarify that Y represents a hydroxyl protecting group. Support is found in the Specification at page 14, lines 6-13.

Claim 13 is canceled.

No new matter has been added.

Summary of the Interview

Applicants sincerely thank Examiner Chung and her supervisor for the courtesy of granting an interview in this application. During the interview, Applicants and the Examiner discussed the indefiniteness rejection, the obviousness rejection and the enablement rejection. The Examiners agreed that, in view of the cited art, the amendments to the claims shown in this Response, would overcome all of the rejections.

Rejections Under 35 USC § 112, First Paragraph (Enablement)

The Examiner has rejected claim 13 for lack of enablement contending that undue experimentation would be required.

Without agreeing with the Examiner, and solely to expedite prosecution, Applicants have canceled claim 13, thereby rendering the rejection moot.

Applicants reserve the right to pursue the subject matter of claim 13 in a continuation application.

Rejections Under 35 USC § 112, Second Paragraph

The Examiner has rejected claim 6 as indefinite, contending that the variable Y is indefinite and that the phrase “a protecting group of a hydroxyl group” is overly broad.

Applicants have amended claim 6, as well as claims 5 and 7 which also contain the above-mentioned phrase, as agreed during the Interview. Consequently, Applicants respectfully request removal of the rejection.

Rejections Under 35 USC § 103

The Examiner has rejected claims 3, 6 and 8 as obvious over Hayashi et al in view of Kuramochi et al. The difference between the compound of the prior art and the instantly claimed compound is that in the prior art R is methyl while in the instant invention R is tert-butyl. The Examiner states that in the absence of a showing of unobvious results the instantly claimed invention is obvious.

As discussed in the Interview, Applicants submit that the Examiner has inadvertently ignored the Declaration of Dr. Kakeya. This Declaration presents evidence of unexpected and surprisingly improved results in a side-by-side comparison of the two compounds, and which the Examiner admitted during the Interview overcame the obviousness rejection of record. Consequently, Applicants respectfully request reconsideration and removal of the rejection.

Conclusion

In view of the above, Applicants submit that the claims are in a position for allowance and request that all rejections be withdrawn.

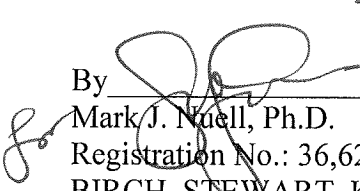
Pursuant to the provisions of 27 C.F.R. §§ 1.17 and 1.136(a), Applicants petition for an extension of one (1) months time for the period in which to file a response to the outstanding Office Action. The Commissioner is hereby authorized to charge Deposit Account 02-2448 the sum of \$130 in connection with the filing of this amendment.

If the Examiner has any questions concerning this application, the Examiner is strongly urged to contact Susan Gorman (Reg. No: 47,604) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to our Deposit Account 02-2448 for any additional fees required under 37.C.F.R. § 1.16 or under § 1.17, particularly extension of time fees.

Dated: November 21, 2008

Respectfully submitted,

By  # 47,604
Mark J. Nuell, Ph.D.
Registration No.: 36,623
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(858) 792-8855
Attorneys for Applicant